

Office Action Summary

Application No.

09/351,399

Applicant(s)

OGINO ET AL.

Examiner

JOHN M. WINTER

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 13, 15, 44, 46 and 63-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 5, 13, 15, 44, 46 and 63-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on August 20, 2008 is hereby acknowledged.

Claims 1,3,4,5,13,15,44,46 are pending.

Response to Arguments

2. The Applicant states that the Office Action does not address the pending claims, for example, independent claim 1 recites a "readout means for reading out media type information from a recording medium, the media type information indicating a type for the recording medium."

The Examiner responds that the language "media type" is directed toward descriptive language that describes information. Examiner notes however that the term "media type" does not serve as a limitation that distinguishes over the prior art, since there is no language in the claim that the process described is in any way dependant upon the "information" being "media type", therefore the Examiner concludes that it would be obvious to one of ordinary skill in the art at the time of the invention that any type of "information" regarding the identification of the media type would meet the limitations of the claimed invention. See following rejection.

The Applicant states that the Office Action fails to address the recitations of dependent claims 63-68.

The Examiner responds, as per claim 63, which recites "the control means outputs the main information signal if the media type information indicates the recording medium is read-only and the copy control information indicates never copy." The Applicant(s) are

reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted. Claims 64-68 contain similar language. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,3,4,5,13,15,44,46 and 63-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-65662 (JP "662 hereinafter) in view of Schneck et al. (Schneck hereinafter: US PAT. 6,314,409 B2) and Ryan et al. (Ryan hereinafter: US PAT. 6,374,036 B1), and further in view of Schneier "Applied Cryptography" (c) 1996.

5. Claims 1 and 13:

JP "662 discloses an information signal playback system having all of the features claimed except for the explicit disclosure of (a) the output means for supplying the media type information on copyright protection encrypted by the encryption means and the unencrypted media type information on copyright protection and the main information signal on which copy control information is embodied to the information signal processing apparatus and (b) a watermark detecting means: see an attached figure. However, Schneck discloses the output means for supplying the media type information on copyright protection encrypted by the encryption means and the unencrypted information on copyright protection and the main information signal on which copy control information is embodied to the information signal processing apparatus and copy control information for a system to control access and distribution of digital property (e.g., Abstract; col. 7, lines 22-50; col. 10, lines 47-65; col. 13, lines 58-62; col. 23, lines 25-27). Further, Ryan discloses the use of watermark for controlling copy of a digital video signal. In column 3, lines 23-35, Ryan discloses comparing values from the watermark to ensure that only authorized use of the digitized work is

allowed. Although Ryan does not specifically disclose that encrypted and unencrypted information are compared, the feature of comparing attributes to known standards is a variation of comparing bits and data streams that one of ordinary skill in the art would recognize as a viable and straightforward means of detecting fraudulent conduct. Thus, it would have been within the level of ordinary skill in the art to modify the system of JP "662 by adopting the teachings of Schneck and Ryan to enhance the functions of the claimed system by providing additional copy protection features. Schneier, on at least pages 30 and 31 discloses the encryption/decryption process using hashing algorithms to produce and compare a string of resultant characters (HASH) before and after transmission of the digital file to ensure that the file was not tampered with enroute to its destination, exactly and clearly disclosing Appellant's limitation of comparing means for comparing the decrypted information on said copyright protection with the unencrypted information on said copyright protection to judge if an attempt to alter the information on said copyright protection has been performed. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system of JP "662/Schneck/Ryan with the hashing technique of Schneier because this would provide an additional layer of protection during transmission of digital files.

Examiner notes that the language "media type" is directed toward descriptive language that describes information. Examiner notes however that the term "media type" does not serve as a limitation that distinguishes over the prior art, since there is no language in the claim that the process described is in any way dependant upon the "information" being "media type", therefore the Examiner concludes that it would be obvious to one of

ordinary skill in the art at the time of the invention that any type of "information" regarding the identification of the media type would meet the limitations of the claimed invention.

6. Claim 44:

None of JP "662, Schneck, Ryan and Downs explicitly discloses the claimed methods. However, it would have been obvious to operate the system, which would have been obvious as stated supra.

7. Claims 3, 15 and 46:

JP "662 does not explicitly disclose the use of CSS system. However, CSS system is one, of old and well-known recording and reproducing system and nothing unobvious is seen to have been involved simply having employed this well known system for an information signal playback system of the sort here involved.

8. Claims 4 and 5:

None of JP "662, Schneck, Ryan and Downs explicitly discloses the use of additional information (additional digital watermark information). However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to any desirable number of digital watermark information, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With regard to the limitation of never-copy or copy once implementations, Ryan discloses using a watermark to enable copy once or never copy permissions for a digital work (abstract and related text). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the copy permissions of Ryan because providing a means for controlling the unauthorized distribution of digital works, "...offers improved security and economics" (Ryan, column 2, lines 30-32).

9. Claims 63-69 are not patentably distinct from the above rejected claims and are rejected for at least the same reasons.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW



